

indicated in red. Assuming that the changes overcome the objections, Applicants respectfully request the Examiner to hold the objection in abeyance until the submission of new formal drawings incorporating the indicated changes.

The Examiner objected to the drawings due to a typographical error on page 3, line 15. By this amendment, Applicants have corrected the error in accordance with the Examiner's helpful suggestion.

### **THE §103 REJECTION**

Claims 1 through 20 were rejected under 35 USC §103 as being unpatentable over U.S. Patent No. 5,395,182 to Rossburger. Insofar as it may be applied to the claims as amended, this rejection is respectfully traversed. Applicants respectfully submit that, for the reasons that follow, the Examiner has failed to establish a prima facie case for obviousness.

The Examiner admits that the Rossburger reference lacks a teaching of "a plurality of walking beams" and "the number of rear roller members being the same as the number of front roller members" (Office Action at par. 4). In the face of this admitted shortcoming, the Examiner asserts that "finding the optimum number of wheels is a design choice dependent on the size of the wheels and environmental conditions such as the width of the road to be compacted" (Office Action at par. 4 (pg. 3, lines 7-9), and that "It would have been obvious to one of ordinary skill in the art to modify the single pivot arm beam of Rossburger to include a plurality of pivot arm beams, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. V. Bemis Co.*, 193 USPQ 8" (Office Action at par. 4 (pg. 3, lines 9-13).

Since the Examiner cites no reference whatsoever for rejections based upon "design choice", Applicants assume that the Examiner has taken "Official Notice" of the existence of such art, as set forth in MPEP Section 2144.03. In accordance with MPEP Section 2144.03, Applicants respectfully traverse the Examiner's assertion of Official Notice, and requests that the Examiner provide a reference or references in support thereof.

Furthermore, Applicants respectfully submit that the Examiner's reliance upon *St. Regis Paper Co. V. Bemis Co.* is misplaced. The *St. Regis* case cannot be

construed to stand for the proposition asserted in rejecting Applicants' claims. Rather, *St. Regis* involved a patent directed to gusseted bags having multiple layers of material. The plaintiff, St. Regis, admitted during the course of litigation that it has sold gusseted multiwall bags in the United States since the early 1930's. In invalidating the St. Regis patent, the court stated that "unless the combination is "synergistic, that is, 'result[ing] in an effect greater than the sum of the several effects taken separately,'" it cannot be patented, and that the plaintiff was "only entitled to a patent if the fusion of the old elements that comprised the Poppe patent and the old element of multiple layering created a synergistic combination", (193 USPQ 8 at 11).

Thus, St. Regis relies upon the concept of "synergy" as a component of non-obviousness. This holding was expressly rejected by the Court of Appeals for the Federal Circuit in *Gardner v. TEC Sys. Inc.*, 725 F.2d 1338 ("Synergism is not a requirement of nonobviousness." *Gardner v. TEC Sys. Inc.*, 725 F.2d 1338, 1349, 220 USPQ 777, 786 (Fed. Cir. 1983) (in banc).

Each of Applicants' claims requires the multiple, independently pivoting walking beams. Claim 1 recites a roller assembly including "a plurality of front roller members" and "a plurality of rear roller members corresponding in number to the plurality of front roller members", with "a plurality of walking beams pivotably connected to the frame member, each of the walking beams connecting one of the front roller members with a respective one of the rear roller members." Claim 13 requires a "roller assembly for compacting road surfaces during paving operations" having "five front roller members", "five rear roller members", and "five walking beams pivotably connected to the frame member, each of the walking beams connecting one of the front roller members with a respective one of the rear roller members". Claim 20 positively recites a "method of compacting paving material distributed on a road surface" including the step of "providing a roller assembly comprising a frame member, a plurality of front roller members, a plurality of rear roller members corresponding in number to the plurality of front roller members, and a plurality of walking beams pivotably connected to the frame member, each of the walking beams connecting one of the front roller members with a respective one of the rear roller members".

The novel and unobvious structure positively recited in Applicants' claims provides many advantages, among which is the "ability to more readily handle irregular and uneven road surfaces", as set forth in Applicants' specification at Page 7.

The Examiner admits that this structure is nowhere to be found in the Rossburger patent. Applicants respectfully submit that Applicants' own specification is the sole motivation for modifying the Rossburger device. This is clearly impermissible.

In view of the foregoing remarks and amendments, Applicant respectfully submits that claims 1 through 20 define allowable subject matter. The Examiner is requested to indicate the allowability of all claims in the application, and to pass the application to issue.

Respectfully submitted,

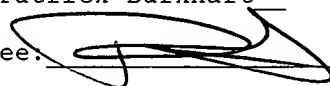


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I hereby certify that this paper or fee is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to Commissioner of Patents, Washington, D.C. 20231, on this

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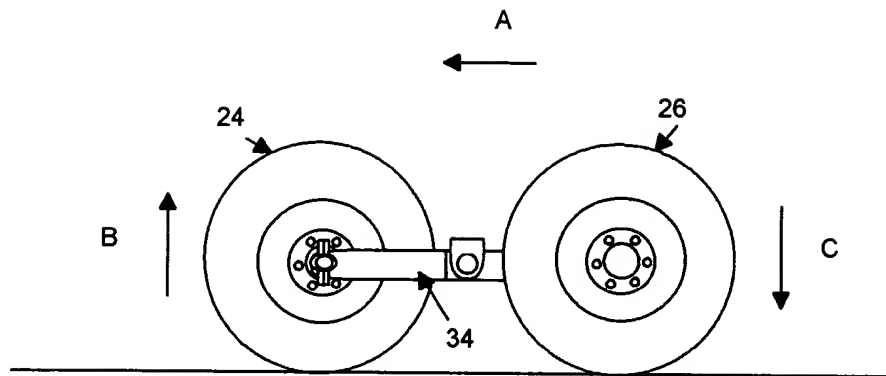


FIG. 5